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| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/544,356                           | 04/06/2000  | Brian Totty          | 50269-036           | 8053             |
| 29989                                | 7590        | 06/22/2005           | EXAMINER            |                  |
| HICKMAN PALERMO TRUONG & BECKER, LLP |             |                      | GOLD, AVIM          |                  |
| 2055 GATEWAY PLACE                   |             |                      | ART UNIT            |                  |
| SUITE 550                            |             |                      | PAPER NUMBER        |                  |
| SAN JOSE, CA 95110                   |             |                      | 2157                |                  |

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/544,356             | TOTTY ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Avi Gold               | 2157                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*pd*

### **DETAILED ACTION**

This action is responsive to the amendment filed on May 27, 2005. Claims 1, 25, and 49 were amended. Claims 1-72 are pending.

### ***Response to Amendment***

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 25, and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The porthole engine responding to an initial request before the requested content is requested from the origin server is not present in the specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 25, and 49 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: The limitation explaining how it is possible for the porthole engine to respond to an initial request and

generate data without the request being sent to the origin server to collect the requested content. The limitation before the newly added one states that the requested content is on an origin server which is separate from the porthole engine.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13, 16-19, 25-37, 40-43, 49-62, and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al., U.S. Patent No. 6,317,761, further in view of Eilbott et al., U.S. Patent No. 6,553,393.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract).

As to claims 1, 25, and 49, Landsman teaches a method, computer readable medium, and a computer system for allowing a porthole engine to deliver unrequested content to users that access requested content through the porthole engine, comprising the steps of:

receiving, from a browser executing on a client, an initial request for requested content (col. 25, lines 46-63; Landsman discloses a user at a client browser requesting a web page);

wherein said initial request is received at said porthole engine (col. 8, lines 1-40; Landsman discloses a request routed to a proxy server);

wherein said client is connected to a network through said porthole engine (col. 8, lines 1-40; Landsman discloses a client PC connected to a proxy server);

wherein said requested content resides on an origin server located separate from said porthole engine on said network (col. 8, lines 1-40; Landsman discloses a proxy server directing a request to a web server); and

said porthole engine responding to said initial request by sending to said client data that causes said requested content and said unrequested content to appear on a display screen of said client (col. 1, lines 26-35; Landsman discloses advertisements transparently downloaded to a client computer and then displayed by a browser).

Landsman fails to teach the limitation further including data generated by the porthole engine.

However, Eilbott teaches managing references to embedded objects in a markup language data stream (see abstract). Eilbott teaches the use of a proxy server generating a list of resources (col. 5, lines 12-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Eilbott to use a porthole engine to generate

data. One would be motivated to do so because it avoids the transfer of data to other servers, which would speed up the generation of data and be more efficient.

Regarding claims 2, 26, and 50, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the portal engine web page content of said requested content to be modified to encapsulate said requested content within a paneled frame (col. 31, lines 65-67; col. 32, lines 1-49; Landsman discloses a browser displaying content in frames).

Regarding claims 3, 27, and 51, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the portal engine causes web page content of said requested content to be modified to reserve space in the web page to display said unrequested content (col. 31, lines 65-67; col. 32, lines 1-49; Landsman discloses frame-targeted ad play).

Regarding claims 4, 28, and 52, Landsman teaches the method, computer readable medium, and a computer system of claims 3, 27, and 51 wherein the space reserved in the web page is selected from a group consisting of:

- the top of the web page;

- the bottom of the web page; and

- a combination of the top of the web page and the bottom of the web page (col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 5, 29, and 53, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the portal engine causes web page content of said requested content to be modified to pop-up one or more display windows to display said unrequested content (col. 32, lines 22-49; Landsman discloses a pop-up window with advertisements).

Regarding claims 6, 30, and 54, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the portal engine causes web page content of said requested content to be modified to replace a portion of said requested content with the unrequested content (col. 1, lines 26-35; Landsman discloses an advertisement displayed on an interstitial basis).

Regarding claims 7, 31, and 55, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said requested content appears on a first portion of a content display region of said browser (col. 9, lines 53-63; col. 10, lines 61-65; Landsman discloses a requested web page displayed to a user); and

said unrequested content appears on a second portion of said content display region of said browser (col. 9, lines 53-63; col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 8, 32, and 56, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said requested content appears on a first display window of said client (col. 9, lines 53-63; col. 10, lines 61-65); and

said unrequested content appears on a second display window of said client (col. 9, lines 53-63; col. 31, lines 65-67; col. 32, lines 1-49).

As to claims 9, 33, and 57, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein said porthole engine determines the format in which to display said requested content and said unrequested content based on one or more factors including at least one of differences in browsers, components of requested web pages, and versions of the browsers (col. 21, lines 10-28; Landsman discloses ad selection based on user specific info collected from and associated with the user operating the browser).

Landsman fails to teach the limitation further including the content format chosen by the porthole engine.

However, Eilbott teaches the use of a proxy server to choose and translate the format of a page (col. 5, lines 12-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Eilbott to use a porthole engine to choose a content format.



Regarding claims 10, 34, and 58, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the step of sending data to said client includes the step of:

sending frame data to said client ;

wherein said frame data defines a plurality of frames;

wherein said plurality of frames includes a first frame and one or more other frames (col. 31, lines 65-67; col. 32, lines 1-49);

wherein said frame data further specifies that said requested content is to be displayed in said first frame, and that said unrequested content is to be displayed in said one or more other frames (col. 9, lines 53-63; col. 10, lines 61-65; col. 31, lines 65-67; col. 32, lines 1-49).

As to claims 11, 35, and 59, Landsman teaches the method, computer readable medium, and a computer system of claims 10, 34, and 58 further comprising the steps of:

the porthole engine receiving a series of subsequent requests from the browser in response to the browser decoding said frame data, said series of subsequent requests including a second request for said requested content (col. 8, lines 41-67; Landsman discloses downloading restarted after another request); and

the porthole engine responding to said second request for said requested content by requesting said requested content from said origin server and delivering said

requested content to said browser (col. 19, lines 25-63; Landsman discloses an agent server downloading contents from another server).

Landsman fails to teach the limitation further including requests received from a browser processed by a proxy server.

However, Eilbott teaches the use of the proxy server requesting a page from the origin server and delivering it to the requesting browser (col. 4, lines 22-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Eilbott to use a proxy server to process requests received from a browser.

Regarding claims 12, 36, and 60, Landsman teaches the method, computer readable medium, and a computer system of claims 11, 35, and 59 wherein said porthole engine determines that said second request for said requested content is not an initial request for said requested content by using information contained in the URL associated with said initial request and with said second request (col. 7, lines 66-67; col. 8, lines 1-40; Landsman discloses the proxy server providing files from cache to other client PCs if they request the same files).

Regarding claims 13, 37, and 61, Landsman teaches the method, computer readable medium, and a computer system of claims 10, 34, and 58 wherein:

said porthole engine determines that said initial request is not a request for an embedded item by using information contained in the URL associated with said initial

request and with said second request (col. 20; lines 58-67; col. 21, lines 1-10;

Landsman discloses an agent checking the URL of a request); and

the step of sending frame data is performed in response to determining that said initial request is not a request for an embedded item (col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 16, 40, and 62, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said porthole engine determines that said initial request is not a request for an embedded item by using information contained in the URL associated with said initial request and with said second request (col. 20; lines 58-67; col. 21, lines 1-10); and

said porthole engine sends data that causes said unrequested content to appear on a portion of said content display region of said browser in response to determining that said initial request is not a request for an embedded item (col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 17, 41, and 65, Landsman teaches the method, computer readable medium, and a computer system of claims 1, 25, and 49 further comprising the step of using information about a particular user to tailor the unrequested content to that particular user (col. 21, lines 10-28).

Regarding claims 18, 42, and 66, Landsman teaches the method, computer readable medium, and a computer system of claim 17, 41, and 65 wherein the information about the particular user is selected from a group consisting of information available to owners of the porthole engine;

information about the requested content; and

a combination of the information available to the owners of the porthole engine and the information about the requested content (col. 21, lines 10-28).

Regarding claims 19, 43, and 67, Landsman teaches the method, computer readable medium, and a computer system of claim 1, 25, and 49 further comprising the step of identifying the users to personalize the unrequested content (col. 21, lines 10-28; Landsman discloses advertisements specifically targeted to the user).

7. Claims 14, 15, 38, 39, 63, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Eilbott further in view of Ackermann, Jr. et al., U.S. Patent No. 6,606,653.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Eilbott teaches the invention substantially as claimed including managing references to embedded objects in a markup language data stream (see abstract).

As to claims 14, 15, 38, 39, 63, and 64, Landsman and Eilbott teach the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Eilbott fail to teach the limitation further including the changing a target attribute of a link in an embedded frame document to affect frame behavior.

However, Ackermann teaches the updating of embedded links or hotspots in source Web pages to reflect the new URLs of moved target Web Pages (see abstract). Ackermann teaches the use of a URL of a link being changed to point to a new URL (col. 5, lines 25-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Eilbott in view of Ackermann to change a target attribute of a link. One would be motivated to do so because it would allow for the proper URL of the link to be shown.

8. Claims 20, 44, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Eilbott further in view of Underwood, U.S. Patent No. 6,704,873.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Eilbott teaches the invention substantially as claimed including managing references to embedded objects in a markup language data stream (see abstract).

As to claims 20, 44, and 68, Landsman and Eilbott teach the method of claims 19, 43, and 67.

Landsman and Eilbott fail to teach the limitation further including the method of Claim 19 wherein the step of identifying the users is performed by a method selected in a group consisting of:

- attaching cookies to web pages that are browsed by a particular user;
- observing the radius authentication transactions and the resulting network address assigned to the client;
- tracking network addresses assigned to the users; and
- authenticating the user.

However, Underwood teaches secure gateway interconnection in an e-commerce based environment (see abstract). Underwood teaches the use of cookie authentication (col. 140, lines 29-46; col. 141, lines 30-45), a RADIUS server performing authentication and allowing traffic from the client (col. 287, lines 65-67; col. 288, lines 1-28), tracking of an IP address (col. 10, lines 3-18), and authenticating the identity of a user (col. 50, lines 34-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Eilbott in view of Underwood to attach cookies to web pages that are browsed by a particular user, observing the radius authentication transactions and the resulting network address assigned to the client, tracking network addresses assigned to the users, and authenticating the user. One would be motivated to do so because they are all efficient methods of identifying a user and personalizing unrequested content for them.

9. Claims 21-23, 45-47, and 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Eilbott further in view of Markus, U.S. Patent No. 6,499,042.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Eilbott teaches the invention substantially as claimed including managing references to embedded objects in a markup language data stream (see abstract).

As to claims 21-23, 45-47, and 69-71, Landsman and Eilbott teach the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Eilbott fail to teach the limitation further including the automatically filling in one or more fields on a requested web page by using a database coupled to the porthole engine.

However, Markus teaches an improved process that allows an entity to automatically release personal data to other entities connected via a computer network (see abstract). Markus teaches the use of a selective proxy server for automatically filling in an online form and a personal data storage component used to for the information to fill the forms in with (col. 1, lines 40-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Eilbott in view of Markus to automatically fill in one or more fields on a requested web page by using a database coupled to the porthole

engine. One would be motivated to do so because it would allow the user to fill in forms without entering anything.

10. Claims 24, 48, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Eilbott further in view of Shapiro et al., U.S. Patent No. 5,991,810.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Eilbott teaches the invention substantially as claimed including managing references to embedded objects in a markup language data stream (see abstract).

As to claims 24, 48, and 72, Landsman and Eilbott teach the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Eilbott fail to teach the limitation further including the use of a content filtering technology based on identities of the users.

However, Shapiro teaches user name authentication for gateway clients accessing a proxy cache server (see abstract). Shapiro teaches the use of automatically restricting access by unauthorized users to specified web information (col. 1, lines 56-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Eilbott in view of Shapiro to use a filter to allow only



authorized users access to particular web pages. One would be motivated to do so because it would allow a way to make certain web pages exclusive.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-72 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,854,897 to Radziewicz et al.

U.S. Pat. No. 6,128,655 to Fields et al.

U.S. Pat. No. 6,338,059 to Fields et al.

U.S. Pat. No. 6,466,975 to Sterling.

U.S. Pat. No. 6,128,651 to Cezar.

U.S. Pat. No. 6,636,247 to Hamzy et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002.

The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

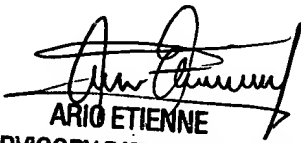
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Avi Gold

Patent Examiner

Art Unit 2157

AMG

  
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